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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,063	02/21/2002	Masato Hoshi	50353-581	9001
20277	7590	05/03/2006	EXAMINER	
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			ALLEN, WILLIAM J	
			ART UNIT	PAPER NUMBER
			3625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/069,063	Applicant(s) HOSHI, MASATO	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/21/02, 11/18/03, 4/5/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/069,063, filed on 2/21/2002.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 20-21 and 27-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements,

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designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claims 20 and 27 fail to recite a computer program that is embodied on a computer-readable medium. The claims are merely directed to a computer program per se.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-4, 7, 14-15, 17-18, 20-23, and 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Cockrill et al. (US 2003/0208442, herein referred to as Cockrill).**

Regarding claim 14, Cockrill teaches:

assigning an individual address to a customer (see at least: abstract, 0018-0019, 0055-0056, 0068, Fig. 8, 9 and 11). The Examiner notes that the email address and member identifier that are assigned to the customer constitute an *individual address* that is assigned to the customer;

memorizing the individual address (see at least: 0068);

examining a subsequent electronic message, if received, to determine whether a destination address of the subsequent electronic message is in agreement with the individual address memorized (see at least: 0065-0069). The Examiner notes that performing additional purchase requests, requesting to register with the system, performing additional log-ins, electronic information sent from the system to the

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customer, and the like constitute *subsequent electronic messages*. Additionally, especially in the case of performing additional log-ins, the system authenticates the unique customer identifier to ensure that the *destination address* of any subsequent communication sent to the customer from the system matches the *individual address memorized* (i.e. the unique customer identifier from paragraph 0068).

Additionally, the Examiner further notes the phrase “examining a subsequent electronic message, *if received*” does not move to distinguish the claimed invention from the cited prior art (Cockrill). This phrase is a conditional limitation. The noted “if” steps are not necessarily performed; thereby, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Regarding claim 15, Cockrill teaches:

wherein an individual address is uniquely assigned to each customer in response to a first act of the customer, and memorized in association with customer information on the customer (see at least: 0018-0019, 0055-0056, 0065-0069);

wherein the customer information control method further comprises:

- *receiving information representing the first act of each customer, and customer information on the customer (see at least: 0018-0019, 0055-0056, 0065-0069);*
- *enabling each customer to express a second act subsequent to the first act by using the individual address assigned to the customer (see at least:*

0018-0019, 0055-0056, 0065-0069). The Examiner notes that after an additional purchase request a customer may perform subsequent logins as well as subsequent purchase requests using the unique customer identifier assigned to them.

Regarding claim 17, Cockrill teaches:

performing a first responsive sales support action in response to the first act from each customer (see at least: abstract, 0018, Fig. 8-9);

performing a second responsive sales support action in response to the subsequent electronic message from the customer only when the destination address of the subsequent electronic message is in agreement with the individual address (see at least: 0065-0069, Fig. 8-9). The Examiner notes that the system of Cockrill is able to perform a second responsive sale action such as confirming purchases, performing additional purchases, etc. as a result of subsequent successful logins.

Regarding claim 18, Cockrill teaches:

wherein the customer information control method further comprises performing a third responsive sales support action in response to the subsequent electronic message from the customer when the destination address of the subsequent electronic message is not in agreement with the individual address (see at least: Fig. 9, 0068). The Examiner notes that preventing accessing during failed authentication constitutes a *third responsive sales support action*.

Regarding claims 1-4 and 7, the limitations set forth in claims 1-4 closely parallel the limitations in claims 14-15 and 17-18. Claims 1-4 are thereby rejected under the same rationale.

Regarding claims 20-21, the limitations set forth in claims 20-21 closely parallel the limitations in claims 14-15 and 17-18. Claims 20-21 are thereby rejected under the same rationale.

Regarding claims 22 and 23, the limitations set forth in claims 22 and 23 closely parallel the limitations in claims 14-15 and 17-18. Claims 22 and 23 are thereby rejected under the same rationale.

Regarding claims 26, 27-28, 29, and 30, the limitations set forth in claims 27-28, 29, and 30 closely parallel the limitations in claims 14-15 and 17-18. Claims 27-28, 29, and 30 are thereby rejected under the same rationale.

Further regarding claim 29, the Examiner further notes the phrase "if a further message is received..." does not move to distinguish the claimed invention from the cited prior art (Cockrill). This phrase is a conditional limitation. The noted "if" steps are not necessarily performed; thereby, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 5-6, 8, 12-13, 16, 24, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill in view of Almeida et al. (US 2004/0083125, herein referred to as Almeida).**

Regarding claims 5 and 16, Cockrill teaches:

wherein the customer information comprises a customer address (see at least: 0068);

the individual address is memorized as a pair with the customer address (see at least: 0055-0056, 0065-0069). The Examiner notes that the member identifier and email address are memorized together as identity information of the customer;

the destination address and a sender address of the subsequent electronic message are examined to determine whether the destination address and the sender address match the individual address memorized and customer address memorized as a pair (see at least: 0065-0069).

Cockrill, however, does not teach *wherein the customer is notified of the individual address by sending, to the customer address, an email message having the individual*

address as a return address. Almeida teaches wherein the customer is notified of the individual address by sending, to the customer address, an email message having the individual address as a return address (see at least: Fig. 1 and 2, abstract, 0030, 0052).

The Examiner notes that when an email message is sent from the agent to vendors/customer the email has the return address indicating the individual address of the agent. Furthermore, the agent handling the requests is assigned to those vendors/customers. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill to have included *wherein the customer is notified of the individual address by sending, to the customer address, an email message having the individual address as a return address* as taught by Almeida in order resolve communication problems between the various parties involved in purchasing auto insurance by providing a centralized communications environment, producing a cost-effective means of communication (see at least: Almeida, 0008, 0012).

Regarding claim 6, the limitations set forth in claim 6 closely parallel the limitations in claims 14-15 and 17-18. Claim 6 is thereby rejected under the same rationale.

Regarding claim 8, Cockrill teaches all of the above and further teaches *wherein the memory section is configured to store the individual address in association with the personal information and purchase-related information for each customer (see at least: 0068).* Cockrill, however, does not teach *wherein the sales support section responds to*

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the first act in the form of a computer-readable electronic message for a sales contract, by performing the sales support action to complete the sales contract; and wherein the sales support section is configured to perform the responsive sales support action in accordance with the customer information which comprises personal information and purchase-related information on a sales contract. Almeida teaches *wherein the sales support section responds to the first act in the form of a computer-readable electronic message for a sales contract, by performing the sales support action to complete the sales contract; and wherein the sales support section is configured to perform the responsive sales support action in accordance with the customer information which comprises personal information and purchase-related information on a sales contract* (see at least: abstract, 0004-0014). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill to have included *wherein the sales support section responds to the first act in the form of a computer-readable electronic message for a sales contract, by performing the sales support action to complete the sales contract; and wherein the sales support section is configured to perform the responsive sales support action in accordance with the customer information which comprises personal information and purchase-related information on a sales contract* as taught by Almeida in order to provide an environment that facilitates doing business between an insurance carrier, an insurance agent, a vendor, and a consumer in a more efficient manner (see at least: Almeida, abstract, 0013).

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Regarding claim 12, Cockrill in view of Almeida further teaches *wherein the purchase-related information comprises credit information on credit for a customer, and the sales support section comprises an examining section to determine whether to allow credit or not, in accordance with the personal information and credit information (see at least: 0016-0019).*

Regarding claim 13, Cockrill in view of Almeida further teaches *wherein the customer information control system comprises a server system which comprises said address assigning section, said memory section, said communicating section, and said checking section, and at least one terminal comprising an input section to input the personal information and purchase-related information, and a communicating section to transmit the personal information and purchase-related information to the server system (see at least: Fig. 8-11, 0065-0069).*

Regarding claims 24 and 25, the limitations set forth in claims 24 and 25 closely parallel the limitations in claims 5, 8, and 16. Claims 24 and 25 are thereby rejected under the same rationale. Additionally, Cockrill shows use of his system via a web site.

7. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill in view of Almeida, as applied to claim 8 above, and further in view of Morohashi et al. (US 6,105,003, herein referred to as Morohashi).

Regarding claim 9, Cockrill in view of Almeida teaches all of the above and further teach a sales support system (see at least: Cockrill, abstract; Almeida, abstract, 0004-0014). Cockrill in view of Almeida does not teach *wherein the sales support section is configured to arrange a date of delivery in response to the first act of each customer for a sales contract, and to notify each customer of the date of deliver for the customer*. Morohashi teaches wherein the sales support section is configured to *arrange a date of delivery in response to the first act of each customer for a sales contract, and to notify each customer of the date of deliver for the customer* (see at least: col. 5 lines 58-65). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill in view of Almeida to have included wherein the sales support section is configured to arrange a date of delivery in response to the first act of each customer for a sales contract, and to notify each customer of the date of deliver for the customer as taught by Morohashi in order to provide for quick sale of desired goods (see at least: abstract).

Regarding claim 10, Cockrill in view of Almeida teaches all of the above as noted and further teaches *wherein the purchase-related information comprises order information* (see at least: abstract); *the sales support section comprises a product data*

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storage section to store data on products (see at least: 0061); a data management section to retrieve data on a product specified by the order information, from the product data storage section (see at least: 0018). Cockrill in view of Almeida, however, does not teach an estimating section to draw up an estimate of the product in accordance with the information obtained from the product data storage section. Morohashi teaches an estimating section to draw up an estimate of the product in accordance with the information obtained from the product data storage section (see at least: abstract, Fig. 10, 12, 15A-15C, 16, and 20). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill in view of Almeida to have included an estimating section to draw up an estimate of the product in accordance with the information obtained from the product data storage section as taught by Morohashi in order to provide for quick sale of desired goods with an estimate based on customer information received (see at least: abstract).

Regarding claim 11, Cockrill in view of Almeida teaches all of the above but does not expressly teach *wherein the purchase-related information comprises trade-in information on a trade-in vehicle; the sales support section comprises a used car data storage section to store information on pre-owned vehicles; a data management section to retrieve data on a trade-in vehicle specified by the trade-in information, from the trade-in data storage section; and an assessing section to draw up an assessment of the trade-in vehicle in accordance with the data obtained from the trade-in data storage section*. Morohashi teaches *wherein the purchase-related information comprises trade-in information on a trade-in vehicle; the sales support section comprises a used car data storage section to store information on pre-owned vehicles; a data management section to retrieve data on a trade-in vehicle specified by the trade-in information, from the trade-in data storage section; and an assessing section to draw up an assessment of the trade-in vehicle in accordance with the data obtained from the trade-in data storage section* (see at least: col. 5 lines 28-33, col. 6 lines 32-44, col. 9, lines 5-16, and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Cockrill in view of Almeida to have included storing trade-in assessment information and pre-owned information as taught by Morohashi in order to provide for quick sale of desired goods with an estimate based on customer information received (see at least: abstract).

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cockrill in view of Official Notice.

Regarding claim 19, claim 19 is directed to submitting, modifying, and communicating to the customer that a modification has not been entered via email. Cockrill further teaches providing the ability of a user to submit and modify orders (see at least: Fig. 8-11, 0092). Cockrill further teaches the system having the capability to resubmit or cancel accounts as a result of problems with the user accounts and confirming outstanding orders with customers (see at least: 0079, 0071). Additionally, Cockrill shows the user of a customer email address in performing necessary purchase steps, though Cockrill does not explicitly show the steps of submitting orders, modifying orders, and being notified that alterations to the accounts are done via an electronic message such as *an email*. The Examiner takes the position that it was old and well known in the art to allow orders, modifications, and various other communications involved with online purchasing to be sent via *email*. It would have been obvious to one of ordinary skill in the art at the time of invention to have included submitting and modifying orders via email, and notifying customer of unaccepted modifications via email as taught by official notice in order to provide an easy means of communication between a customer and a business entity. Additionally, applicant has not persuasively demonstrated the criticality of providing this step versus the steps disclosed by Cockrill.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh Garg can be reached on (571) 272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William J. Allen
Patent Examiner
April 30, 2006

Mark
Primary Examiner